REMARKS / ARGUMENTS

The present application includes pending claims 1-42, of which claims 1-31 have been rejected. Claims 1-42 are pending in the instant application. Claims 1, 11, 21-23, 25-29, 32-34, and 36-41 have been amended. Claims 2-10, 12-20, 22-31, and 33-42 depend from independent claims 1, 11, 21, and 32, respectively.

Claims 1-4, 7-14, 17-24, and 27-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over "The Gnutella Protocol Specification v0.4" ("Gnutella"). Claims 5-6, 15-16, and 25-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gnutella in view of USPP 2002/0194309 ("Carter"). The Applicant respectfully traverses these rejections at least based on the following remarks.

I.   Improper Rejection under 35 U.S.C. § 102(b)

The Examiner has rejected claims 1-4, 7-14, 17-24, and 27-42 under 35 U.S.C. § 102(b). *See* the Office Action at page 2. However, in light of Examiner's arguments in page 3 of the Office Action, the Applicant assumes that the Examiner meant to reject claims 1-4, 7-14, 17-24, and 27-42 under 35 U.S.C. § 103(a), instead of 35 U.S.C. § 102(b). This was further confirmed by the Examiner in a telephone call on 10/14/2008. Therefore, the Applicant will consider claims 1-4, 7-14, 17-24, and 27-31 as being rejected under 35 U.S.C. § 103(a), and not under 35 U.S.C. § 102(b).

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

> The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

> The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

II.   Gnutella Does Not Render Claims 1-4, 7-14, 17-24, and 27-31 Unpatentable

The Applicant now turns to the rejection of claims 1-4, 7-14, 17-24, and 27-31 as

being unpatentable over Gnutella. The Applicant notes that Gnutella forms the basis for

all of the pending rejections.

A.   Rejection of Independent Claims 1, 11, 21, and 32

With regard to the rejection of independent claim 1 under 103(a), the Applicant

submits that Gnutella does not disclose or suggest at least the limitation of

"automatically and without user intervention, initiating detection and detecting whether

one or more of new media, data and/or service becomes newly available within the

distributed network," as recited by the Applicant in independent claim 1.   The Office

Action states the following:

> With regard to claim 1, Gnutella discloses a method for communicating
> information in a distributed media network, the method comprising:
>
> automatically detecting, without user intervention, whether one or more
> of new media, data and/or service within the distributed network is
> available (Gnutella: Page 1, "Query". The "Query" descriptor is used for
> finding media that is available on the network. Further, the actual act of
> detecting is performed automatically. Even if the user initiates the act of
> detecting with a query, the act itself is performed automatically and
> without user intervention.);
>
> …
>
> Gnutella does not disclose expressly detecting whether the one or more of
> new media, data, and/or service becomes newly available. However, a
> person of ordinary skill in the art would have known how to perform this
> functionality. Thus, it would have been obvious to detect whether the one
> or more of new media, data, and/or service becomes newly available. The

suggestion/motivation for doing so would have been that a user making multiple queries would perform this function. If the first query does not return a hit, the user may make a second query after the first query returned no hits. A user who wishes to find specific data (e.g. a specific media file) may make several requests for the media file in cases where the first request did not return any results. A second request would possibly return results, as the user would recognize that Gnutella only returns results if a user currently logged in has the file at the time of the query. As users are downloading files, logging on, and logging off, when the first query was made, no one currently on the network may have had the file, but at a later time, the file may become newly available, as a user on the network just obtained and shared the file, or a user with the file just logged onto the network. Thus, having a user perform a second query after a first query fails to return results allows the user to find media files that have become newly available, allowing the user to acquire the desired file.

See the Office Action at pages 2-3. The Office Action relies for support on Gnutella's Query descriptor. The Applicant points out that the Query descriptor of the Gnutella protocol is used only **by a user** for purposes of searching a local data set by the servant that receives the Query descriptor. *See* Gnutella at page 1. More specifically, **the Query descriptor is used to locate a match (and a QueryHit) against <u>existing</u> data within the local data set of the specific servant. <u>The Query descriptor, as well as any of the remaining Gnutella descriptors, is *not* used for purposes of initiating detection and detecting whether media, data, and/or service become newly available.</u>**

Furthermore, a user has to specifically designate the search criteria (or the search string) for purposes of using the Query descriptor. In other words, <u>the</u>

Query descriptor, as well as any other descriptor of the Gnutella protocol,
requires user participation **and, therefore, cannot be used for purposes of**
"automatically and without user intervention, initiating detection and detecting"
newly available media. Obviously, Gnutella requires the user to initiate the
detection, and no detection can be performed without such user intervention.

The Examiner states the following in the "Response to Arguments" section of the
Office Action:

> On pages 17-19, Applicant argues that Gnutella cannot disclose or
> suggest "automatically detecting, without user intervention, whether one or
> more of new media, data and/or service becomes newly available within
> the distributed network." However, as addressed above, the user simply
> initiates the process, but the actually detecting is performed automatically
> and without user intervention. Accordingly, the rejections of claims 1, 11,
> and 21 have been maintained even in light of Applicant's amendments and
> arguments.

See the Office Action at page 11. In response to the above argument from page 11 of
the Office Action (Examiner's "Response to Arguments" section), the Applicant points
out that the Examiner took the position that **the action of "detecting" will not be**
performed but for the initiating action of the user. Accordingly, the Examiner has
conceded that "the user simply initiates the process..." Obviously, without the
user initiating the detection process, there will be no detection taking place. For
purposes of furthering prosecution, the Applicant has further clarified independent
claims 1, 11, 21, and 32 to further distinguish the Gnutella reference.

Therefore, the Applicant maintains that Gnutella does not (and cannot) disclose or suggest at least the limitation of "automatically and without user intervention, initiating detection and detecting whether one or more of new media, data and/or service becomes newly available within the distributed network," as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not unpatentable over Gnutella and is allowable. Independent claims 11, 21, and 32 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11, 21, and 32 are also not unpatentable over Gnutella at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 3-4, 7-10, 12-14, 17-20, 22-24, 27-31, and 33-42

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, 21, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Gnutella has been overcome and requests that the rejection be withdrawn. Additionally, claims 3-4, 7-10, 12-14, 17-20, 22-24, 27-31, and 33-42 depend from independent claims 1, 11, 21, and 32, respectively, and are, consequently, also respectfully submitted to be allowable at least based on the above reasons.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 3-4, 7-10, 12-14, 17-20, 22-24, 27-31, and 33-42.

III. The Proposed Combination of Gnutella and Carter Does Not Render Claims 5-6, 15-16, and 25-26 Unpatentable

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Gnutella has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Carter) does not overcome the deficiencies of Gnutella, claims 5-6, 15-16, and 25-26 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 5-6, 15-16, and 25-26.

IV. TRAVERSAL OF OFFICIAL NOTICE

The Examiner states the following in the "Response to Arguments" section of the Office Action:

> The Applicant submits that the Examiner has performed "a thorough search of the prior art," as part of the Examiner's obligation in examining the present application under MPEP § 904.02. Additionally, the Applicants

respectfully submit that the Examiner's searched and cited references found during the Examiner's thorough and detailed search of the prior art are indicative of the knowledge commonly held in the art. However, in the Examiner's thorough and detailed search of the relevant prior art, none of the prior art taught or suggested the subject matter of the perceived and explicit assertions of Official Notice." However, this statement is irrelevant to a taking of Official Notice. As Applicant indicates, the Official Notice should be of "notorious character" and "capable of instant and unquestionable demonstration as being well-known," as stated in MPEP 2144.03.

See the Office Action at page 12. In the 10/15/08 response, the Applicant is simply questioning whether the Examiner is even allowed to take Official Notice under the circumstances. According to MPEP § 2144.03(A), Official Notice, without supporting references, should only be asserted when the subjects asserted to be common knowledge are "capable of instant and unquestionable demonstration as being well-known." **The fact that all the prior art references produced by the Examiner's search do not disclose or suggest the features subject to official notice, is evidence that these features are not common knowledge. Therefore, the Examiner cannot take Official Notice without providing supporting evidence, as required by MPEP.**

Furthermore, the Examiner has provided the following reasoning that the features subject to official notice are "capable of instant and unquestionable demonstration as being well-known":

The suggestion/motivation for doing so would have been that when a file is downloaded, the user should be able to decide whether the file will be processed or not. For example, if a user downloads a song, the user

should be able to then determine if the song will actually be played (which would be processing the song's file) or just stored. This allows a user who is downloading many files or downloading larger files to determine when the file will actually be processed, and further allows security software operations (i.e. virus scan) to be performed on the file prior to processing the file.

See the Office Action at page 5. The Applicant respectfully disagrees with the above reasoning. **It is not necessarily true that "when a file is downloaded, the user should be able to decide whether the file will be processed or not." More often than not, such determination is not necessary when the file is downloaded. For example, a user may initiate a download of newly available media at a personal media device. The personal device may be set to record only certain number of newly available downloads. The user does not need to decide, upon the media download, how such media will be processed. Instead, the newly available media is simply being saved and a determination of whether to process the media (e.g., view it) or not (e.g., delete it) is made at a later time. Therefore, the features subject to Examiner's official notice are <u>not</u> "capable of instant and unquestionable demonstration as being well-known."**

Therefore, the Applicant maintains the previous traversal of Official Notice, which is summarized again herein below.

The Examiner has taken Official Notice with regard to Applicant's claims 2, 3, 8, and 10. *See* the Office Action at pages 4-8. More specifically, the Examiner is taking Official Notice with respect to the language of claim 2, which recites "determining

whether said stored migrated newly available one or more of new media, data and/or service should be processed"; claim 3, which recites "if said stored migrated newly available one or more of new media, data and/or service is to be processed, migrating said stored migrated newly available one or more of new media, data and/or service into one or both of a media view and/or a channel view"; claim 8, which recites "scheduling said migration of said newly available one or more of new media, data and/or service to one or both of said first media processing system and/or a second media processing system within the distributed media network"; and claim 10, which recites "archiving said stored newly available one or more of new media, data and/or service."

Assuming the Office Action is asserting Official Notice that the subject of these statements is common knowledge, the Applicant respectfully traverses the perceived and explicit assertions as further set forth below. Alternatively, if the Office Action's assertions are based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37 C.F.R. § 1.104(d)(2), the assertions must be supported by an affidavit from the Examiner.

According to MPEP § 2144.03(A), Official Notice, without supporting references, should **only** be asserted when the subjects asserted to be common knowledge are "capable of instant and unquestionable demonstration as being well-known." That is, the subjects asserted must be of "notorious character" under MPEP § 2144.03(A). However, **the Applicants respectfully submit that the subject matter of the**

perceived and explicit assertions of Official Notice is not well-known in the art as evidenced by the searched and cited prior art. The Applicant respectfully submits that the Examiner has performed "a thorough search of the prior art," as part of the Examiner's obligation in examining the present application under MPEP § 904.02. Additionally, the Applicants respectfully submit that the Examiner's searched and cited references found during the Examiner's thorough and detailed search of the prior art are indicative of the knowledge commonly held in the art. However, in the Examiner's thorough and detailed search of the relevant prior art, <u>none</u> of the prior art taught or suggested the subject matter of the perceived and explicit assertions of Official Notice. That is, the Examiner's thorough and detailed search of the prior art has failed to yield any mention of the limitations in claims 2, 3, 8, and 10, which the Office Action concedes are not explicitly found in Gnutella, and which the Examiner asserts are widely known in the art. The Applicant respectfully submits that if the subject matter of these assertions of Official Notice had been of "notorious character" and "capable of instant and unquestionable demonstration as being well-known" under MPEP § 2144.03(A), then the subject matter would have appeared to the Examiner during the Examiner's thorough and detailed search of the prior art.

If the Examiner had found any teaching of relevant subject matter, the Examiner would have been obligated to list the references teaching the relevant subject matter and make a rejection. Consequently, the Applicant respectfully submits that the prior

art does not teach the subject matter of the perceived assertion of Official Notice and respectfully traverses the perceived assertion of Official Notice.

The Applicants specifically challenge the perceived and explicit assertions of Official Notice with regard to claims 2, 3, 8, and 10. As stated above, the Applicant respectfully traverses the perceived and explicit assertions of Official Notice and submits that the subject matter is not of such "notorious character" that it is "capable of instant and unquestionable demonstration as being well-known." Under MPEP 2144.03, the Examiner is now obligated to provide a reference(s) in support of the assertions of Official Notice if the Examiner intends to maintain any rejection based thereon. Additionally, the Applicant respectfully requests the Examiner reconsider the assertion of Official Notice and provide any basis for the assertions of Official Notice.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-42 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 20-MAR-2009   /Ognyan I. Beremski/

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